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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,569	08/06/2001	Kenichi Sakuma	862.C2324	7063
5514 7590 07/05/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER RUHL, DENNIS WILLIAM	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 07/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/921,569

Applicant(s)

SAKUMA ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/17/07 has been entered.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 61-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 61-63, it is not clear as to what is being claimed with respect to the transmission unit. It is claimed that the determination unit or the check unit decide certain situations are present, and it is claimed that the transmission unit **is adapted to transmit** "window information *for displaying...*" to the user terminal. What does this mean? What is the scope of "window information" that is "for displaying" information such as a repair fee estimate or information on new products. What is the "window information" that is being claimed? One wishing to avoid infringement would not know what kind of information is included in the scope of this term and what kind of information is not. The way the claim is written, the window information is not the same as the information such as the repair estimate or the information on new products that is

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actually to be displayed to the user, so what is the "window information" comprised of?

The window information is "for displaying" other information, what does this mean? This is not clear. Also, what structure is being defined by reciting the ability of the transmission unit to transmit certain kinds of information? This is not clear. What is being claimed in sections 1-3, other than the ability of the transmission unit to transmit certain types of data to the user terminal? This language is purely functional language and it is not clear as to what structure applicant is claiming here regarding the transmission unit. The pending claims are system claims (apparatus type claims) and structure is what is given patentable weight. Other than claiming a transmission unit that is adapted to transmit various types of data, what structure is being defined by sections 1-3 of the independent claims as amended? This is not clear. The claims are considered indefinite.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 61-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (6609050) in view of Wong (5432904).

For claims 61,63,64,66 (as best understood),67,69, Li discloses a system and method for administering warranty services and repair services for automobiles. Li discloses a management server that has a *storage unit* in the form of databases 93 and 94 (col. 4 , lines 26-33). The databases store information about customer's vehicles. The *check unit* that is adapted to check whether or not certain equipment is under warranty or not is 41. See column 4, lines 26-28 and column 6, lines 49-51. This determination inherently involves the use of the customer database as claimed. The *estimation unit* that can calculate a repair estimate fee is disclosed in column 8, lines 6-23 and figure 23. On the basis of a code, such as "002", the standardized hours for this service are retrieved, which is what the repair estimate is based on. Because the estimate for the repair is disclosed as being generated, and because a repair estimate inherently includes the cost of any parts needed to do the repair, it is inherent that there is a *determination unit* that determines the "price of the equipment" by looking it up in a database as claimed (in a party specifying table). This is a part of the repair estimate process. The *transmission unit* (claims 61-63) that is adapted to transmit certain information to the user via a network is the hardware and software of the system of Li that outputs data to the terminal of a user, such as the person requesting or viewing the

estimate data that the system provides. Li necessarily has a data transmission unit (i.e. data ports, a modem, software for data transfer, etc.). To the extent that the language of claim 61 regarding the transmission unit in the apparatus claims defines any structure, Li satisfies that structure because Li discloses a transmission unit that transmits data such as a repair fee estimate to a user terminal. The transmission unit of Li is fully capable of transmitting the claimed types of information and will transmit whatever kind of data it is requested to send. The kind of data the system is intended to send is not defining any further structure to the claimed system (claim 61). The data is sent over a network as claimed.

Not disclosed is that there is a *determination unit* that determines whether or not a *ratio of the repair fee estimate to the "specified price"* (the price for a new part) is a predetermined value or more (this applies to all independent claims). Not disclosed is the step of transmitting a method of recovering an article to be repaired and a type of method for delivery of the article as claimed in independent claims 64,67.

Wong discloses an auto repair estimating system that provides estimates for auto repairs. Wong discloses that the system has the ability to compare the cost for repairing a particular part to the cost of replacing the part to see which one is cheaper and is a better decision. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Li with a determination unit that determines whether or not the cost of a repair is greater than a predetermined fee, such as the cost of a replacement part, so that it can be seen which is cheaper. If it costs more to repair something than to simply replace the part, one would surely want to

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have the part replaced, because the cost is cheaper and you get a totally new part. The output of this analysis would be the cost to repair versus the cost to replace, which satisfies the claimed limitation of the transmission unit being adapted to transmit information about a repair estimate and new products (the new part itself). With respect to the recitation that it is a ratio that is being compared, one of ordinary skill in the art would have recognized that one could do the comparison step of a repair to a replacement by either comparing the costs outright, or by using a ratio, where if the value of the ratio is less than 1, this indicates that the repair costs less than a replacement. This is just another mathematical way to compare the two numbers and is something that would have been obvious to one of ordinary skill in the art.

With respect to the recitations in section #1,#2, the examiner has already addressed the transmission of the information about the repair fee estimate and the new products information. Not disclosed is the step of transmitting a method of recovering an article to be repaired and a type of method for delivery of the article as claimed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to not only provide the repair estimate and the information on how much a new part costs, but it would have been obvious to also provide other types of information to the customer, such as how one can go about having their vehicle repaired (satisfies the "method for recovering an article to be repaired), when it may be done (method for delivering), information on possible rental cars provided to the customer, etc... One of ordinary skill in the art would appreciate and understand that other types of information can also be displayed to the user. Applicant is attempting to define over the prior art

solely by the information that is being displayed to the customer and not being further used in any other method step. This seems to be a recitation that is directed to non-functional descriptive material due to the fact that the method for recovering or method for delivery is never really used any further in the claims. It is not proper to give patentable weight to data that is just different from the prior art but that is also not even used in the claims in any further manipulative steps. The examiner has set forth an obviousness statement, but at the same time believes this language to be non-functional descriptive material that does not serve as a limitation.

With respect to section #3, not disclosed is that if the equipment is under warranty, window information is transmitted for displaying a type of method for recovering the article and a method for delivery for the repaired article, without transmitting the repair fee estimate. It would have been obvious to one of ordinary skill in the art at the time the invention was made to not send the repair estimate as part of the information when the equipment is covered under warranty. If it is covered under warranty, as far as the customer is concerned, the repair cost is information of little value because the cost is covered due to the fact it is under warranty. Also, when the equipment is covered under warranty, it would have been obvious to one of ordinary skill in the art at the time the invention was made to also provide other types of information to the customer, such as how one can go about having their vehicle repaired (satisfies the "method for recovering an article to be repaired), when it may be done (method for delivering), information on possible rental cars provided to the customer, any special warranty information such as deductibles, etc... One of ordinary

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skill in the art would appreciate and understand that other types of information can also be displayed to the user. Applicant is attempting to define over the prior art solely by the information that is being displayed to the customer and not being further used in any other method step. This seems to be a recitation that is directed to non-functional descriptive material due to the fact that the method for recovering or method for delivery is never really used any further in the claims. It is not proper to give patentable weight to data that is just different from the prior art but that is also not even used in the claims in any further manipulative steps. The examiner has set forth an obviousness statement, but at the same time believes this language to be non-functional descriptive material that does not serve as a limitation.

For claims 62,65,68, Li inherently has a table specifying parts as claimed, this was addressed with respect to claim 61. Not disclosed is that the estimation unit looks up a *delivery date specifying table*. This is interpreted to be the act of determining whether or not a particular part is in stock or not, which indicates the delivery date to the customer. If the part is in stock, then the repair could potentially be done the same day, whereas if the part needs to be ordered, it may take a day or more to obtain the necessary part, which would also depend on the part needed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the system of Li determine the "delivery date" of a part by determining if the part is in stock or not. This satisfies what is claimed.

7. Applicant's arguments filed 4/17/07 have been fully considered but they are not persuasive.

The examiner notes applicant's arguments and refers applicant to the rejections of record where the newly added claims language has been addressed. Applicant has argued that the prior art does not disclose what is claimed in steps 1-3. The examiner disagrees in that the claim language is broad in scope and is considered to be obvious under 35 USC 103. Applicant is attempting to define over the prior art solely by the information that is being displayed to the customer and not being further used in any other method step. This seems to be a recitation that is directed to non-functional descriptive material due to the fact that the method for recovering or method for delivery is never really used any further in the claims. It is not proper to give patentable weight to data that is just different from the prior art but that is also not even used in the claims in any further manipulative steps. The examiner has set forth an obviousness statement, but at the same time believes this language to be non-functional descriptive material that does not serve as a limitation.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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DENNIS RUHL
PRIMARY EXAMINER